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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/836,903	04/17/2001	Markku Verkama	781.395USW1	7798
32294	7590	08/30/2005	EXAMINER	
SQUIRE, SANDERS & DEMPSEY L.L.P. 14TH FLOOR 8000 TOWERS CRESCENT TYSONS CORNER, VA 22182			GREY, CHRISTOPHER P	
			ART UNIT	PAPER NUMBER
			2667	

DATE MAILED: 08/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/836,903

Applicant(s)

VERKAMA, MARKKU

Examiner

Christopher P. Grey

Art Unit

2667

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on amendment filed on April 7, 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☒ Claim(s) 17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 9 and 17 are rejected under 112 second paragraph

1. Regarding claims 1, 9 and 17, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

2. Claim 17 is rejected as failing to define the invention in the manner required by U.S.C. 112, second paragraph.

The claim is narrative in form and does not contain positively recited steps of specific process. Note that method claims should set forth a series of steps in the active tense in an instruction-like manner thereby reciting an actual method. Dependant claims should further limit base claims by reciting additional steps in a like-wise function. Ex parte Erlich, 3USPQ2d 1011 at 1017[6].

Claim Objections

3. Claim 1 is objected to because of the following informalities:

The following underlined claimed subject matter is unclear to the examiner in that it seems repetitive;

"with a Packet Data Protocol address, or PDP address of the same mobile terminal."

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 17 is rejected under 35 U.S.C. 102(b) as being anticipated by Qureshi (Wo 97/27713)

Claim 17 Qureshi discloses an MSC initiating a request invoke message (page 33 lines 27-30 and page 24 line 22-page 25 line 7).

Qureshi discloses a SCP transferring new service information to mobile subscribers (page 17 lines 20-26 (page 13 lines 20-page 14 lines 6)).

Qureshi discloses the subscribers existing in a cellular environment (packet switched network) as disclosed on page 4 lines 26-30.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Qureshi (WO 97/27713) in view of Begeja et al. (US 20040076140).

Claim 13 Qureshi discloses a MSC requesting information from an SCP unit (page 13 lines 1-12), where information pertaining to services is found (Col 24 lines 1-12 and Col 13 lines 20-6).

Qureshi discloses the MSC being connected (element 37 in fig 4) to a SCP.

Qureshi discloses providing IN services which are sent from the SMAS to a subscriber (page 17 lines 20-26).

Qureshi does not specifically disclose the PDP address of the mobile terminal being stored in the service control point.

Begeja discloses an SCP and an SCP database for storing information regarding a mobile user's identification number and IP address (paragraph 0023, 0029 and see fig 2A).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to combine the SCP database as disclosed by Begeja within the SCP as disclosed by Qureshi. The motivation for this modification is to allow a user to access a

service provider using an IP connection, where access may be made through the SCP (paragraph 0022).

Claim 14 Qureshi discloses transmitting a query, and then processing the call to a subscriber (page 13 lines 1-12 and page 24 lines 14-22).

Claim 15 Qureshi discloses a service management application for sending new services information to the SCP to be forwarded to the mobile terminal (page 13 line 20- page 14 line 6).

Claim 16 Qureshi discloses a service management application for sending new services information to the SCP to be forwarded to the mobile terminal (page 13 line 20- page 14 line 6).

Qureshi does not specifically disclose using the current PDP address to send the information.

Begeja discloses using an IP address to send information over a TCP/IP network (paragraph 0032).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to combine the database as disclosed by Begaja within the SCP as disclosed by Qureshi, allowing information to be sent using an IP address mapped from an identifier, thus allowing for information to be correctly routed over an internet connection.


6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher P. Grey whose telephone number is (571)272-3160. The examiner can normally be reached on 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chi Pham can be reached on (571)272-3179. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher Grey
Examiner
Art Unit 2667

C. Grey
8/11/05


CHI PHAM
SUPERVISORY PATENT EXAMINE
TECHNOLOGY CENTER 2667 8/16/05